

REMARKS

Claims 1-59 are pending in the present Application, and all claims currently stand rejected. Claim 1 is amended herein. Reconsideration of the Application in view of the foregoing amendment and the following remarks is respectfully requested.

35 U.S.C. § 102(b)

On page 4 of the Office Action, the Examiner rejects claims 1, 4-9, 11, 13-15, 17, 21, 24-29, 31, 33-35, 37, 41-42, 47-48, and 50-52 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,396,537 to Squilla et al. (hereafter Squilla). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Squilla fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

With regard to the Examiner’s rejections of independent claims 1, 21, and 41, Applicants submit that these claims recite similar limitations that are nowhere disclosed by Squilla. For example, independent claim 1 now recites “*said one or more ancillary data files being selected and downloaded through selection decisions that are able to be made in all instances only by said system user, said selection decisions being made in all instances prior to said download of*”

said ancillary data files,” and “said one or more ancillary data files including one or more image data files that said imaging device combines with said image data to create a new composite image that integrates both said image data and at least one of said ancillary data files into a single image” (emphasis added), which are limitations that are not taught or suggested either by the cited reference, or by the Examiner’s citations thereto.

Squilla teaches a camera that wirelessly receives content data directly from an “image spot” that is located at an “attraction site.” (see column 2, lines 30-65). However, Applicants submit that Squilla fails to teach any sort of on-line procedures in which ancillary data files are selected and downloaded as a result of “selection decisions” that are capable of being made only by a system user in all situations, as claimed by Applicants. On the contrary, Applicants submit that Squilla expressly states that “the personality file is used by the respective processors 76, 14 in the image server 70 and the image spot 10 to choose content data” (emphasis added) (see column 6, lines 57-59). For at least the foregoing reasons, Applicants submit that Squilla fails to teach “*said one or more ancillary data files being selected and downloaded through selection decisions that are able of being made in all instances only by said system user*”(emphasis added), as claimed by Applicants.

On page 5 of the Office Action, the Examiner cites columns 5 and 6 of Squilla against Applicants’ claimed “new composite image.” Applicants respectfully traverse, and submit that Squilla nowhere teaches combining any sort of downloaded ancillary data and captured image data to create a “new

composite image,” as recited by Applicants. In particular, Applicants submit that Squilla fails to teach creating “a new composite image that integrates both said image data and at least one of said ancillary data files as a single image” (emphasis added), as claimed by Applicants.

Squilla states that “the data stored in the personality file 52 will determine what extra data is going to be used This content can be uploaded to the camera 24 and selected using the preview function (column 8, lines 43-47) (emphasis added). Applicants therefore submit that Squilla teaches downloading content data to the camera first, and then selecting which downloaded content to retain. Applicants therefore submit that Squilla fails to teach “*said selection decisions being made in all instances prior to said download of said ancillary data files,*” as claimed by Applicants. For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1, 21, and 41.

Regarding the Examiner’s rejection of dependent claims 4-9, 11, 13-15, 17, 24-29, 31, 33-35, 37, 47-48, and 50-52, for at least the reasons that these claims are dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 4-9, 11, 13-15, 17, 24-29, 31, 33-35, 37, 47-48, and 50-52, so that these claims may issue in a timely manner.

With further regard to the rejection of claim 47, the Examiner cites columns 4-5 of Squilla for support. Applicants traverse, and submit that the cited passages of Squilla nowhere teach or suggest the various details of the “off-line procedure” that are recited by Applicants in claim 47. Applicants therefore request reconsideration and withdrawal of the rejection of claim 47.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Squilla to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1, 4-9, 11, 13-15, 17, 21, 24-29, 31, 33-35, 37, 41-42, 47-48, and 50-52, so that these claims may issue in a timely manner.

On page 10 of the Office Action, the Examiner rejects claim 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereafter 039). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that 039 fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21, as

discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of 039 and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of the cited references.

As previously stated, Applicants specifically direct the Examiner’s attention to Applicants’ discussion of FIG. 8 (Specification, page 14, line 26 through page 16, line 31) which describes in detail the Applicants’ claimed invention. Based upon the foregoing remarks, Applicants submit that specific recited limitations of claim 42 have been identified in the Specification and in the arguments made with respect to claims 1 and 21. Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite 039 to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of independent claim 42 so that this claim may issue in a timely manner.

35 U.S.C. § 103(a)

On page 11 of the Office Action, the Examiner rejects claims 2 and 22 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent

No. 6,930,709 to Creamer et al. (hereafter Creamer). The Applicants respectfully traverse these rejections for at least the following reasons. Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that certain basic criteria must be met.

In particular, Applicants submit that the cited prior art reference (or references when combined) should teach all the claim limitations recited by Applicants. The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants submit that this burden has not been adequately met because the cited prior art fails to teach all of Applicants' claimed limitations.

Regarding the Examiner's rejection of dependent claims 2 and 22, for at least the reasons that these claims are directly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2 and 22, so that these claims may issue in a timely manner.

In addition, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no specific teaching

of a combination that would result in Applicants' invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

For at least the foregoing reasons, the Applicants submit that claims 2 and 22 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 2 and 22 so that these claims may issue in a timely manner.

On page 13 of the Office Action, the Examiner rejects claims 3, 23, and 46 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent No. 6,950,130 to Qian (hereafter Qian), and yet further in view of U.S. Patent No. 6,223,190 to Aihara et al. (hereafter Aihara). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 3, 23, and 46, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the

limitations of the respective independent claims, are also not identically taught or suggested. For at least the foregoing reasons, the Applicants submit that claims 3, 23, and 46 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 3, 23, and 46, so that these claims may issue in a timely manner.

On page 15 of the Office Action, the Examiner rejects claims 10, 18-20, 30, and 38-40 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent No. 6,177,957 to Anderson (hereafter Anderson). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 10, 18-20, 30, and 38-40, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration

and allowance of dependent claims 10, 18-20, 30, and 38-40, so that these claims may issue in a timely manner.

Furthermore, with regard to claims 18 and 38, the Examiner concedes that Squilla fails to teach an “off-line management procedure including a file descriptor identification procedure” Applicants concur. The Examiner then points to Anderson to purportedly remedy these deficiencies. Anderson is limited to teaching a camera device that accesses “executable files” from a “flash disk”. Applicants therefore submit that Anderson fails to teach a “data source being implemented as a computer in a distributed computer network,” as claimed by Applicants.

For at least the foregoing reasons, the Applicants submit that claims 10, 18-20, 30, and 38-40 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10, 18-20, 30, and 38-40, so that these claims may issue in a timely manner.

On page 19 of the Office Action, the Examiner rejects claims 12, 32, 49, and 53-55 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of Aihara. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior

art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Independent claim 53 has been amended to recite elements and functionality similar to those recited in claims 1 and 21, as discussed above. Applicants therefore incorporate those prior remarks by reference with regard to claim 53. In addition, Applicants submit that Squilla fails to teach ancillary data files that are "limited" to "image data files." On the contrary, Squilla specifically teaches that "[s]uch data may include . . . audio clips or reference material . . ." (see column 4, lines 60-65).

Regarding the Examiner's rejection of dependent claims 12, 32, 49, and 54-55, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 12, 32, 49, and 54-55, so that these claims may issue in a timely manner.

In addition, Applicants submit that Aihara is directed towards only creating a "web page." In contrast, Applicants claim creating "*ancillary data files*," and not a web page. For at least the foregoing reasons, the Applicants submit that claims 12, 32, 49, and 53-55 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request

reconsideration and withdrawal of the rejections of claims 12, 32, 49, and 53-55, so that these claims may issue in a timely manner.

On page 23 of the Office Action, the Examiner rejects claims 16 and 36 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent No. 5,477,264 to Sarabadhikari et al. (hereafter Sarabadhikari). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 16 and 36, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 16 and 36, so that these claims may issue in a timely manner.

Furthermore, Applicants submit that Sarabadhikari fails to teach "said special instruction file being alternately formatted **both** as an embedded

instruction file that is embedded in said selected ancillary data file and a discrete instruction file that is not embedded in said selected ancillary data file” (emphasis added), as claimed by Applicants. For at least the foregoing reasons, the Applicants submit that claims 16 and 36 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 16 and 36, so that these claims may issue in a timely manner.

On page 24 of the Office Action, the Examiner rejects claim 43 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent No. 6,195,511 to Harada (hereafter Harada). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations.” The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner’s rejection of dependent claim 43, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants

therefore respectfully request reconsideration and allowance of dependent claim 43, so that this claim may issue in a timely manner.

In addition, the Examiner states that “Harada is found to teach the rewriting of camera programming . . .” (emphasis added). In contrast, Applicants specifically claim that the ancillary data module “deletes” a local “ancillary data file.” Applicants submit that their claimed ancillary data file is not the same as the “camera programming” recited in Harada. Furthermore, Applicants submit that deleting an image data file is not the same as “rewriting” taught by Harada.

For at least the foregoing reasons, the Applicants submit that claim 43 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 43 so that this claim may issue in a timely manner.

On page 25 of the Office Action, the Examiner rejects claim 44 under 35 U.S.C. § 103 as being unpatentable over Squilla, Aihara, and Qian, and further in view of U.S. Patent No. 6,721,001 to Berstis (hereafter Berstis), and yet further in view of U.S. Patent No. 6,894,694 to Silverbrook et al. (hereafter Silverbrook), . The Applicants respectfully traverse this rejection for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior

art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejections of dependent claim 44, for at least the reason that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 44, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered "as a whole" when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants' claim 44 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejection under 35 U.S.C. § 103(a) is improper. Applicants further suggest

that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 44 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claim 44, so that this claim may issue in a timely manner.

On page 27 of the Office Action, the Examiner rejects claim 45 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of U.S. Patent No. 6,731,305 to Park et al. (hereafter Park), and further in view of U.S. Patent No. 6,968,058 to Kondoh et al. (hereafter Kondoh), and yet further in view of U.S. Patent No. 5,717,496 to Satoh et al. (hereafter Satoh). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 45, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 45, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered "as a whole" when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants' claim 45 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejections under 35 U.S.C. § 103(a) are improper. Applicants further suggest that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to

combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 45 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 45 so that this claim may issue in a timely manner.

On page 28 of the Office Action, the Examiner rejects claim 56 under 35 U.S.C. § 103 as being unpatentable over Squilla and Aihara in view of U.S. Patent No. 6,535,243 to Tullis (hereafter Tullis). The Applicants respectfully traverse this rejection for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejections of dependent claim 56, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of dependent claim 56, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants

therefore respectfully request reconsideration and allowance of dependent claim 56, so that this claim may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claim 56 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 56, so that this claim may issue in a timely manner.

On page 29 of the Office Action, the Examiner rejects claims 57-58 under 35 U.S.C. § 103 as being unpatentable over Squilla and Aihara in view of '039. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejections of dependent claims 57-58, for at least the reasons that these claims are dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants

therefore respectfully request reconsideration and allowance of dependent claims 57-58, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 57-58 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 57-58, so that these claims may issue in a timely manner.

On page 30 of the Office Action, the Examiner rejects claim 59 under 35 U.S.C. § 103 as being unpatentable over Squilla, Aihara, and Qian, and further in view of U.S. Patent No. 6,721,001 to Berstis (hereafter Berstis), and yet further in view of U.S. Patent No. 6,894,694 to Silverbrook et al. (hereafter Silverbrook), . The Applicants respectfully traverse this rejection for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined should teach all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejections of dependent claim 59, for at least the reason that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim,

when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 59, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered “as a whole” when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants’ claim 59 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejection under 35 U.S.C. § 103(a) is improper. Applicants further suggest that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 59 is not unpatentable over the cited references, and that the rejection is thus

improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claim 59, so that this claim may issue in a timely manner.

Summary

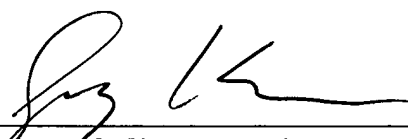
Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-59 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

4/19/09

By: _____


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